

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re

Decision on Petition for Review Under 37 CFR § 10.2(c)

(Petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (Director) dated September 1, 1998 (Director's Decision), granting-in-part and denying-in-part Petitioner's request for a higher score on the morning section of the Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office held on August 27, 1997 (Examination). The petition is denied.

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both morning and afternoon sections of the Examination. Petitioner scored a 64 on the morning section of the Examination.

On April 30, 1998, Petitioner requested a regrade of six questions from the morning section of the Examination: Nos. 10, 13, 29, 30, 33, and 50. On September 1, 1998, the Director granted Petitioner's regrade request for Question No. 10 and added two points to the score; the Director denied Petitioner's regrade request for the remaining Questions (Nos. 13, 29, 30, 33, and 50).

Petitioner now asks the Commissioner to reverse the Director's decision denying credit for three questions on the morning section of the Examination: Nos. 13, 29 and 30.

Opinion

Pursuant to 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions to the morning section state: "No points will be awarded for incorrect answers or unanswered questions." The burden is upon the Petitioner to show that their chosen answer is the most correct answer. Petitioner has failed to meet this burden.

Furthermore, Petitioner's arguments contain assumptions that are not supported by the facts presented in the questions. The directions to the morning section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette.

Petitioner has presented various arguments attacking the validity of the model answers and the Director's decision. All of Petitioner's arguments have been considered, but lack merit. For the following reasons, no points will be added to Petitioner's score for the morning section of the Examination.

Question No. 13

Question 13 read as follows:

13. Inventor Jones retained registered practitioner P to prepare and file a patent application claiming Jones' invention. P prepared and filed the application together with a declaration wherein Jones appointed P to represent him and conduct all business before the PTO. While P was away on a vacation, Jones filed a preliminary amendment in the application amending the claims, and no Office action on the merits was issued by the PTO examiner. The amendment was signed by Jones, but not P. When P returned from vacation, Jones provided P with a copy of the amendment. Upon review of the amendment, P realized that the scope of the claims had been broadened, that the broadened claims are supported by the original disclosure, and that the claims now read upon prior art which Jones disclosed to P, but which was not disclosed in the specification. The prior art reference is not material to the patentability of the original claims in the application. Which of the following actions of P accords with proper PTO practice and procedure and is the most likely to place the application in condition for allowance?

- (A) File a supplemental amendment arguing that the Jones amendment should not be entered on the ground that 37 CFR § 1.33 provides that "Double correspondence with an applicant and his attorney or agent...will not be undertaken."
- (B) File a supplemental amendment canceling all amendatory changes effected by the Jones amendment.
- (C) File a supplemental amendment which (1) cancels all the claims in the patent application, (2) adds the original claims, and (3) argues that the newly added claims are supported by the disclosure.
- (D) File a supplemental amendment which (1) adds the original claims, (2) cites to the examiner the prior art reference disclosed by Jones to P with an explanation of how the newly added claims patentably distinguish over such prior art reference, and (3) argues that the added claims are supported by the disclosure.
- (E) File a supplemental amendment which (1) adds the original claims, (2) cites to the examiner the prior art reference disclosed by Jones to P with an explanation of how all the claims in the application patentably distinguish over such prior art reference, and (3) argues that all the claims in the application are supported by the disclosure.

In the model answer, choice (C) is identified as the correct answer based on 37 C.F.R.

§ 1.56 and MPEP 2001.04. A supplemental amendment which cancels all existing claims, adds the original claims, and argues that the original claims are supported by the disclosure will place the application in condition for allowance.

Petitioner argues that (E) is also a correct answer based on the fact that P could have changed her mind. Specifically, Petitioner argues that P could have changed her mind and no longer thought the broadened, amended claims read on the prior art. Based on this assumption, Petitioner argues that P was then free to argue that the broadened, amended claims were patentable over the prior art.

Petitioner, however, improperly assumes that P changed her mind. The directions to the morning part of the examination expressly state, "Do not assume any additional facts not presented in the questions." (Emphasis added). Question 13 expressly states, "Upon review of the amendment, P realized that the scope of the claims had been broadened, that the broadened claims are supported by the original disclosure, and that the claims now read upon prior art which Jones disclosed to P, but which was not disclosed in the specification. (Emphasis added). Nothing in the question indicates P changed her mind and thus Petitioner is wrong to make such an assumption. Therefore, since P thought that the claims read on the prior art, it would be a violation of 37 C.F.R. § 1.56 for her to argue the contrary position. Thus, choice (E) is incorrect.

Petitioner's request for credit on question 13 is denied.

Question No. 29

Question 29 reads as follows:

29. You have filed a complete plant patent application claiming 1) a distinct and new plant variety and 2) a method for obtaining the plant variety. Which of the following statements is/are false?

- I. You may not amend the application to add additional description of the plant variety inadvertently omitted from the original application.
 - II. You may be required to deposit an adequate sample of the plant variety with an acceptable depository and the claims may be rejected under 35 U.S.C. § 112 without the deposit.
 - III. You may be required to restrict the claims between plant variety and plant method inventions you want examined for ultimate issuance as the single claim in the plant patent application to which you are entitled.
- (A) III.
 - (B) II and III.
 - (C) I and II.
 - (D) I and III.
 - (E) I, II, and III.

In the model answer, choice (C) is identified as the correct answer based on MPEP 1605.

MPEP 1605 states:

If the written description of a plant is deficient in certain respects, a clarification or additional description of the plant, or even a wholesale substitution of the original description so long as not totally inconsistent and unrelated to the original description and photograph of the plant, will not constitute new matter under 35 U.S.C. 132. *Jessell v. Newland*, 195 USPQ 678, 684 (Dep. Comm'r Pat. 1977).

(Emphasis added). Thus, since MPEP 1605 specifically provides that there are circumstances where one may amend the application to add additional description of the plant variety inadvertently omitted from the original application, Statement I is false.

In addition, MPEP 1605 further provides:

The rules on Deposit of Biological Materials, 37 CFR 1.801 - 1.809, do not apply to plant patent applications in view of the reduced disclosure

requirements of 35 U.S.C. 162, even where a deposit of a plant has been made in conjunction with a utility application (35 U.S.C. 101).

(Emphasis added). Therefore, since MPEP 1605 expressly states that the rules on deposits of biological materials do not apply to plant patent applications, Statement II is false.

Statement III provides that you "may" be required to restrict the claims between plant variety and plant method inventions. MPEP 1608 explains that plant patent applications are subject to the same examination process as any other national application, with the sole exception being set forth in 35 U.S.C. § 162. Restriction, pursuant to 35 U.S.C. § 121, is part of the examination process and is not excluded in Section 162. Thus, because the examiner could restrict the claims pursuant to 35 U.S.C. § 121, Statement III is a true statement. Therefore, since Statements I and II are false, and since Statement III is true, choice (C) is the correct answer.

Petitioner selected choice (B). Petitioner first argues Statement I is true because the statement uses the words "may not amend" rather than "cannot amend". Petitioner argues that since new matter may not be added in an amendment, it is true that one may not amend. However, Petitioner improperly assumes facts not stated in the question. Statement I neither mentions anything regarding, nor is limited to, amendments where new matter is added. In addition, Petitioner essentially admits that in a case where no new matter is introduced, one may amend. Therefore, since Statement I provides that one "may not amend" the application, it is a false statement.

Next Petitioner argues Statement III is true since an examiner cannot restrict unpatentable subject matter. Specifically, Petitioner argues that since a method claim in a plant patent application is improper and not patentable, a restriction requirement could never occur.

MPEP 1605 does state that a method claim in a plant patent application is improper. However, this does not mean that if a method claim was included in a plant patent application it could never be restricted. Restricting two claims neither requires, nor infers, that either claim being restricted is necessarily patentable. Specifically, 37 C.F.R. § 1.142(a) provides that a restriction requirement will generally be made "before any action on the merits." A restriction requirement only requires that the claims be directed towards independent and distinct inventions. These independent and distinct inventions, may or may not, constitute patentable subject matter. In fact when two claims are restricted, it is impossible to predict whether one or both or neither will issue. Finally, Petitioner argues that it would be proper for the examiner to reject the method claims in a patent application. Although this may be a second option for the examiner, since Statement III states you "may" be required to restrict the claims, it is a true statement.

Petitioner's request for credit on question 29 is denied.

Question No. 30

Question 30 reads as follows:

30. Banana, Inc. wishes to cite a prior art reference, consisting of a patent, to the PTO to be entered into the file of an issued patent owned by Orange, Inc. Which of the following is necessary to ensure that the prior art reference is entered into the patent file?

- (A) Banana's citation of the reference must be accompanied by an explanation of the pertinency and manner of applying the reference to at least one of the claims of the patent.
- (B) The term of the patent must not have expired.
- (C) The reference must present a substantial new question of patentability.
- (D) Banana's citation of the reference must be accompanied by the appropriate fee.
- (E) Both (B) and (C).

In the model answer, choice (A) is identified as the correct answer based on 35 U.S.C. § 301 and MPEP 2202, 2204, and 2205. Section 301, which is entitled "Citation of prior art," provides:

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation will become a part of the official file of the patent.

35 U.S.C. § 301. Similarly, 37 C.F.R. § 1.501(a) provides:

At any time during the period of enforceability of a patent, any person may cite to the Patent and Trademark Office in writing prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of a particular patent.

Thus, if one cites a reference and explains its pertinency and application to at least one of the claims, both the reference and the explanation will be entered into the patent file. Therefore, choice (A) is the correct answer.

Petitioner selected choice (E). Petitioner argues that choice (A) is not correct since, in her opinion, "citation of the reference . . . accompanied by an explanation of the pertinency and

manner of applying the reference to at least one of the claims of the patent," does not comply with the language of Section 301 (i.e., "explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent"). A simple side-by-side comparison of the language of choice (A) with that of Section 301 illustrates the weakness of Petitioner's argument:

explanation of the pertinency and manner of applying the reference to at least one of the claims of the patent

explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent

Thus since the actions set forth in choice (A) clearly satisfy the requirement of Section 301, choice (A) is the correct answer. Petitioner's technical argument that choice (A) is wrong since it does not use the exact words of Section 301 is unpersuasive.

In addition, Petitioner's choice (E) is clearly wrong. Choice (E) indicates that both choices (B) and (C) must occur to ensure that the prior art reference is entered into the patent file. Choice (B) would require that the term of the patent must not have expired. However this is incorrect, since citations of prior art may be submitted, and subsequently entered into the file, up to six years after the patent expires. See MPEP 2204. Choice (C) is also incorrect since prior art may be entered into a patent file regardless of whether a reexamination is warranted. See 35 U.S.C. § 301. Thus, Petitioner's choice (E) is clearly incorrect.

Petitioner's request for credit on question 30 is denied.

CONCLUSION

Petitioner's grade for the morning section will not be changed. The final grade for the morning section is 66 points.

ORDER

Upon consideration of the Petition to the Commissioner under 37 CFR § 10.2(c), it is ORDERED that the petition is denied.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", is written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks

cc: